

REMARKS

This Amendment is fully responsive to the non-final Office Action dated September 15, 2009, issued in connection with the above-identified application. Claims 1-20 are pending in the present application. With this Amendment, claims 1, 6-10 and 17-19 have been amended; and claims 12-16 and 20 have been canceled without prejudice or disclaimer to the subject matter therein. No new matter has been introduced by the amendments made to the claims. Favorable reconsideration is respectfully requested.

To facilitate the Examiner's reconsideration of the present application, the Applicants have provided amendments to the specification and the abstract. The changes to the specification and the abstract include minor editorial and clarifying changes. Replacement portions of specification and a replacement abstract are enclosed. No new matter has been introduced by the amendments made to the specification and the abstract.

In the Office Action, claims 9-11 have been objected to for being dependent on a rejected base claim. However, the claims would be allowable if rewritten in independent form to include all the limitations of their base claim and any intervening claims. The claims have not been rewritten in independent form (as suggested by the Examiner) at this time because the amendments and arguments provided herein are believed to be sufficient to overcome the rejection to the independent claim from which claims 9-11 depend. Withdrawal of the objection to claims 9-11 are respectfully requested.

In the Office Action, claim 18 has been rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter. Specifically, the Examiner alleges that the claim is directed to a program *per se*, which is non-statutory subject matter. The Applicants have amended claim 18 to recite that the program is stored on "a computer-readable recording medium," which is clearly statutory (see MPEP 2106.01). Withdrawal of the rejection under 35 U.S.C. 101 is respectfully requested.

In the Office Action, claims 1-8 and 17-19 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Kikuchi et al. (European Patent No. 1195766, hereafter "Kikuchi").

The Applicants have amended independent claims 1 and 17-19 to more clearly distinguish the present invention from the cited prior art. Independent claim 1 (as amended) recites the following features:

"[a] recording apparatus for recording contents, said recording apparatus comprising:

a drive unit operable to have a portable recording medium removably attached;
a relief recording medium;
an obtaining unit operable to obtain specification information which specifies one or more portable recording media to be used for recording a content;
a recording control unit operable to perform control so that (i) in a case where one of the specified portable recording media is attached to said drive unit when the content is to be recorded, the content is recorded onto the attached portable recording medium, and (ii) in a case where none of the specified portable recording media are attached to said drive unit when the content is to be recorded, the content is recorded onto said relief recording medium; and
a dubbing control unit operable to, when triggered by a detection that one of the specified portable recording media is attached to said drive unit after the content has been recorded onto the relief recording medium, dub the recorded content from said relief recording medium onto the one of the specified portable recording media." (Emphasis added).

The features emphasized above in independent claim 1 are similarly recited in independent claims 17-19 (as amended). Specifically, claim 17 is an integrated circuit having similar features of the apparatus of claim 1. Claim 18 is a computer-readable recording medium and claim 19 is a method, and both claims include steps directed to the features of the apparatus of claim 1. Additionally, the features emphasized above in independent claim 1 (and similarly recited in independent claims 17-19) are fully supported by the Applicants' disclosure (see e.g., pg. 30-33; pg. 53-55; and Figs 3, 6 and 7).

The present invention (as recited in independent claims 1 and 17-19) is distinguishable from the cited prior art in that content is recorded onto a relief recording medium not only when there is no portable recording medium attached to a drive unit, but also when a portable recording medium different from a desired portable recording medium specified by a user is attached to the drive unit. Furthermore, when the content has been recorded onto the relief recording medium, the content is dubbed onto the specified portable recording medium when triggered by a detection that the specified portable recording medium (i.e., specified by specification information) has been attached to the drive unit.

To this end, a user need not select a portable recording medium or perform a dubbing operation. A user can simply specify a desired portable recording medium in order to record the content, which enables the content to be ultimately recorded onto the specified portable

recording medium regardless of whether or not the specified portable recording medium is attached to a drive unit when recording the content has started. Thus, even if a portable recording medium (i.e., that is different from a specified portable recording medium) is attached to the drive unit when recording content, it is not necessary for the user to check onto which recording medium the content has been recorded. Additionally, the user can easily manage the recorded content which is especially advantageous when there is a plurality of portable recording media.

In the Office Action, the Examiner relies on Kukuchi for disclosing or suggesting all the features recited in independent claims 1 and 17-19. However, the Applicants assert that Kukuchi fails to disclose or suggest the features now recited in independent claims 1 and 17-19, as amended.

Kukuchi discloses a recording/reproducing apparatus that includes a built-in hard disk and an optical disc drive, wherein the built-in hard drive is used as a temporary storage (see e.g., ¶ [0072]). As described in Kukuchi, information to be recorded onto an optical disc is temporarily recorded in the temporary storage, when the optical disc is being replaced with a new disc due to a lack of disc space (i.e., when the optical disc is removed from the optical disc drive), or when the optical disc drive is in a busy state due to a seeking or a track jump operation (see e.g., ¶ [0073] and ¶ [0090]). The information temporarily recorded on the hard disk is eventually transferred and stored onto the optical disc (see e.g., ¶ [0154]).

However, Kukuchi fails to disclose or suggest at least the following features of the present invention (as recited in independent claims 1 and 17-19): (i) a recording control unit (or step) that switches a recording destination in accordance with the specification information and a portable recording medium attached to the drive unit; and (ii) a dubbing control unit (or step) that dubs the content onto a specified portable recording medium upon detection that the specified portable recording medium has been attached to the driving unit.

To the contrary, Kukuchi merely records content temporarily onto a relief recording medium, such as a hard disk, if no portable recording medium is attached to the drive unit when content is to be recorded. Therefore, in Kukuchi, if a portable recording medium attached to the driving unit is different from the one desired by the user when recording content, the apparatus simply records the content onto the attached recording medium (i.e., regardless of whether the portable recording medium is selected or desired by the user). Similarly, if a portable recording

medium is attached to the drive unit after the content has been recorded onto the hard disk drive, the content may be dubbed on the portable recording medium regardless of whether or not the attached portable recording medium is the one desired by the user.

As a result, with the apparatus disclosed in Kukuchi, a user could be confused with regard to which portable recording medium was used to record the content. Also, if the content is recorded on a portable recording medium that is different from a specified portable recording medium (i.e., desired by the user), the user will need to further specify the desired portable recording medium to dub the content to the desired portable recording medium.

Accordingly, the device disclosed by Kukuchi is clearly different from the present invention (as recited in independent claims 1 and 17-19), and cannot provide the same advantages of the present invention noted above.

Based on the above discussion, Kukuchi fails to anticipate or render obvious the features of independent claims 1 and 17-19 (as amended). Likewise, Kukuchi fails to anticipate or render obvious the features of claims 2-11 at least by virtue of their dependencies (directly or indirectly) from independent claim 1.

In light of the above, the Applicants submit that all the pending claims are patentable over the prior art of record. The Applicants respectfully request that the Examiner withdraw the rejections presented in the outstanding Office Action, and pass the present application to issue. The Examiner is requested to contact the undersigned attorney by telephone to resolve any issues remaining in the present application.

Respectfully submitted,

Koji MIYAGAWA et al.

/Mark D. Pratt/

By 2009.12.11 11:32:20 -05'00'

Mark D. Pratt
Registration No. 45,794
Attorney for Applicants

MDP/ckb
Washington, D.C. 20005-1503
Telephone (202) 721-8200
Facsimile (202) 721-8250
December 11, 2009